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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/628,644

07/28/2003

Gregory A. Ehlers

68,180-005

4901

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7590

07/23/2008

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EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

07/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/628,644	<b>Applicant(s)</b> EHLERS ET AL.	
	<b>Examiner</b> Igor N. Borissov	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,5,6,8-10,14-26,28-30,35,37,38,40,41,44-57,60,64 and 65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5,6,8-10,14-26,28-30,35,37,38,40,41,44-57,60,64 and 65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

Amendment received on 05/09/2008 is acknowledged and entered. Claims 1, 2, 4, 7, 11-13, 31-34, 36, 39, 42, 43, 58, 59, 61, 62 have been canceled. Claims 3, 5, 6, 8, 10, 14, 20-23, 25, 26, 28-30, 37, 38, 40, 41, 44, 45, 48, 51-54, 56, 57, 60 have been amended. New claims 64 and 65 have been added. Claims 3, 5, 6, 8-10, 14-26, 28-30, 35, 37, 38, 40, 41, 44-57, 60, 64 and 65 are currently pending in the application.

Terminal Disclaimer of 05/09/2008 is acknowledged and entered.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3, 5, 6, 8-10, 14-26, 28-30, 35, 37, 38, 40, 41, 44-57, 60, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Jr. et al. (US 4,847,782) in view of Kirk et al. (US 4,998,024) and further in view of Rudden et al. (US 4,998,024).**

Brown, Jr. et al. (Brown) teaches a method and system for energy distribution system with a responder unit having an override, comprising:

Claims 64 and 65

allowing each customer to individually subscribe to one or more of a plurality of energy management programs defined by the utility (C. 2, L. 21-40);

measuring the instantaneous rate at which the commodity is being delivered to each device at the plurality of customer sites;

sending the instantaneous rate at which the commodity is being delivered to each device to the utility;

providing a device type indicator to the utility for each device, the device type indicator identifying the type of the device (C. 2, L. 41-50);

defining a subset of the devices at the utility, wherein the subset of devices includes devices of the same type in use by the subscribing customers (C. 5, L. 22-31);

determining at the utility, in real time, the capacity of the commodity that can be managed for the subset of devices by activating the subscribed energy management program for the subset of devices, wherein the subscribed energy management program defines whether the subscribing customers can override the subscribed energy management program after activation (C. 5, L. 6-31; C. 13, L. 8-25);

activating at least one of the subscribed energy management programs when the total demand for the commodity approaches a threshold capacity determined by the utility, wherein activation of the subscribed energy management program adjusts operational settings for each device of the subset of devices to reduce consumption of the commodity by the subset of devices (C. 5, L. 6-31; C. 7, L. 61 - C. 8, L. 9);

if permitted by the subscribed energy management program, overriding the adjusted operational settings for each device during activation of the subscribed energy management program upon request by the subscribing customer (C. 13, L. 8-25).

Brown does not specifically teach verifying, in real time, a reduction in the rate at which the commodity is being delivered to each device of the subset of devices following activation of the subscribed energy management program.

Brown also does not specifically teach that if not permitted by the subscribed energy management program, preventing the override of the adjusted operational settings for each device during activation of the subscribed energy management program upon request by the subscribing customer;

providing an incentive, such incentive including at least one of a fixed billing adjustment, a proportionally scaled billing adjustment, an incentive rate, and a rebate, to

each subscribing customer based on the actual reduction in the rate the commodity is delivered to the customer site following activation of the subscribed energy management program.

Kirk et al. (Kirk) teaches a method and system for distributing energy to customers, wherein energy demand is controlled by the power utility, and wherein each customer has override option, comprising: verifying, in real time, a reduction in the rate at which the commodity is being delivered to each device of the subset of devices following activation of the subscribed energy management program (C. 3, L. 46-54).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown to include said “verifying” feature, as disclosed in Kirk, because it would advantageously allow to stimulate customers to continue to participate in the power reduction program.

Rudden et al. (Rudden) teaches a method and system for distributing energy to customers, wherein energy demand is controlled by the power utility, and wherein each customer has override option, wherein, if permitted by the subscribed energy management program, customer can override the power utility induced settings (C. 5, L. 45-48), and if not permitted by the subscribed energy management program, preventing the override of the adjusted operational settings for each device during activation of the subscribed energy management program upon request by the subscribing customer (Rudden discloses monitoring customer compliance with no-override program to be entitled to a reward or compensation; C. 6, L. 33-37);

providing an incentive, such incentive including at least one of a fixed billing adjustment, a proportionally scaled billing adjustment, an incentive rate, and a rebate, to each subscribing customer based on the actual reduction in the rate the commodity is delivered to the customer site following activation of the subscribed energy management program (C. 6, L. 33-37).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown and Kirk to include: if not permitted by the subscribed energy management program, preventing the override of the adjusted

operational settings for each device during activation of the subscribed energy management program upon request by the subscribing customer;

providing an incentive, such incentive including at least one of a fixed billing adjustment, a proportionally scaled billing adjustment, an incentive rate, and a rebate, to each subscribing customer based on the actual reduction in the rate the commodity is delivered to the customer site following activation of the subscribed energy management program, as disclosed in Rudden, because it would advantageously allow to power utility to lower peak demand, thereby fulfilling contractual obligations. Furthermore, in this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. *See Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Claims 3, 5, 6, 8-10, 14-26, 28-30, 35, 37, 38, 40, 41, 44-57, 60, same reasoning as applied to claims 64 and 65.

### ***Response to Arguments***

Applicant's arguments with respect to claims 3, 5, 6, 8-10, 14-26, 28-30, 35, 37, 38, 40, 41, 44-57, and 60 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628